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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,061	08/29/2001	Bobby Hu	CFP-1080CA	8157

7590 06/03/2003

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EXAMINER	
SHAKERI, HADI	

ART UNIT	PAPER NUMBER
3723	17

DATE MAILED: 06/03/2003

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 17

Application Number: 09/942,061
Filing Date: August 29, 2001
Appellant(s): HU, BOBBY

Alan D. Kamrath
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/13/03.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on 03/13/03 has been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 21-25, 40, 41 and 57-59 stand or fall together because appellant's brief indicates that these claims are grouped together and does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

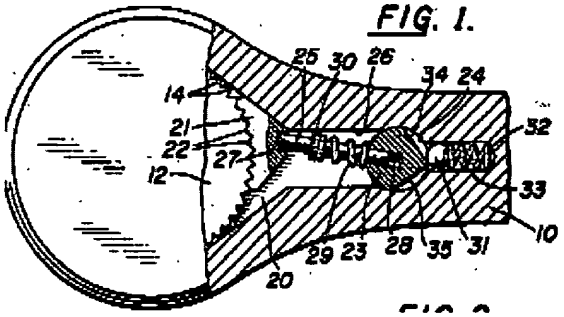
3,265,171	KILNESS	08-1966
1,426,127	TUTTLE	08-1922
5,533,427	CHOW	07-1996
5,178,047	ARNOLD ET AL.	01-1993

1,957,462	KRESS	05-1934
5,957,009	McCann	09-1999
6,164,167	CHEN	12-2000
5,076,121	FOSELLA	12-1991
6,282,991	HU	09-2001
6,282,992	HU	09-2001
6,453,779	HU	09-2002
6,457,389	HU	10-2002
US 2002/0112573 (09/854,795)	HU	08-2002
US 2002/0166416 (09/888,810)	HU	08-2002

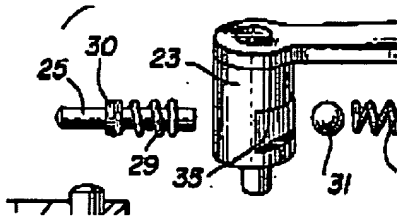
(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

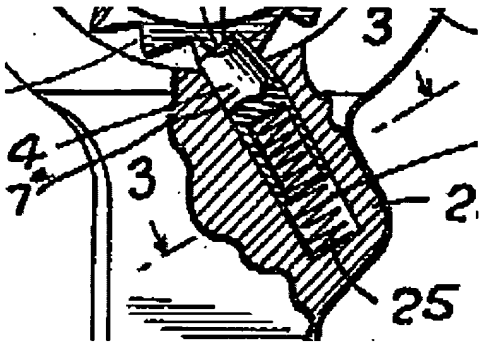
Claims 21, 23, 41 and 57-59 are rejected under 35 U.S.C. 103(a) over Kilness in view of Tuttle.



Kilness discloses all the limitations of claim 21, i.e., a drive member including a plurality of teeth, a pawl (21) including a first side with teeth (22) and a second side with a recess (27), a switch member including a turn piece (36), an actuating plate (23) with a first receptacle (28), an elastic element (29), a peg (25) with a first end received in the pawl and a second end received in the first receptacle and including a second receptacle (receiving the spring) with a second end wall (30), with the elastic member located between the first end wall and the second end wall, except that it does not disclose the elastic



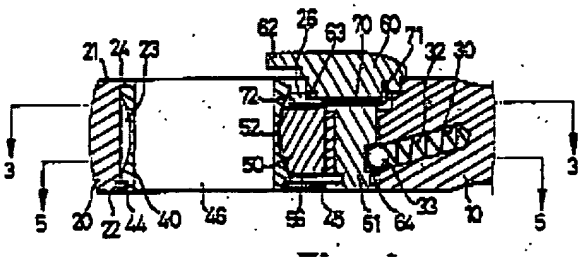
member to be located in the first receptacle. Different embodiments of actuating member, in which the elastic member is located in a peg's receptacle and a second receptacle having an end wall against which the elastic member is biasing against, is old and known in the art as illustrated by Tuttle. Further, applicant has not disclosed that utilizing this embodiment solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the actuating means as disclosed by other embodiments. It is known in the art, as shown by Tuttle, to use a peg having a receptacle and an elastic member located in the peg's receptacle and another receptacle to biased the peg. The two are art recognized functional equivalents. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tool of Kilness by replacing the actuating means, in view of Tuttle, as the two are art recognized functional equivalents.



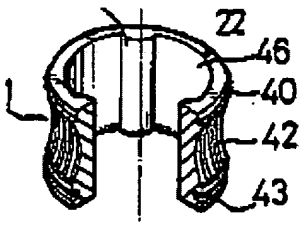
Regarding claims 23, 41, 57-59, Prior Art (PA) meets the limitations.

Claims 22, 25, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kilness in view of Tuttle as applied to claim 21 above, further in view of Chow.

Kilness in view of Tuttle as described above meets all the limitations of claim 22, except for the drive member to be a gear wheel. Chow teaches a ratchet wrench with a gear wheel. It would have been obvious



to one of ordinary skill in the art, at the time the invention was made, to further modify the modified tool of prior art with a gear wheel as taught by Chow to adapt the tool for with a gear wheel for engaging with like fasteners.

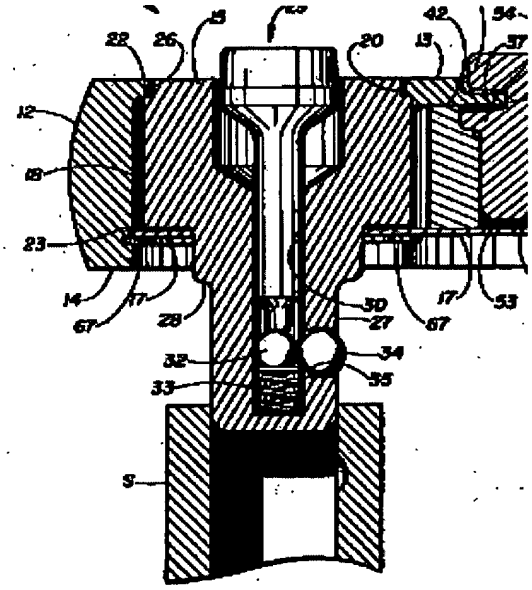


Regarding claim 25, Kilness in view of Tuttle and Chow meets the limitations, i.e., first annular groove (28), a second annular groove (43), and a C-clip (44).

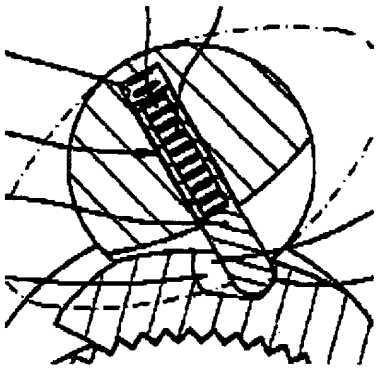
Regarding claim 40, Kilness in view of Tuttle and Chow meets the limitations.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kilness in view of Tuttle as applied to claim 21 above, further in view of Arnold et al.

Prior art as described above meets all the limitations of claim 24, except for the end wall and the stub. Arnold et al. teaches a ratchet wrench with a head having an end wall (26) and a drive member with a stub (29). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the tool of Kilness with a drive member with a column as taught by Arnold et al. to adapt the tool for engaging with like fasteners having quick release mechanism.

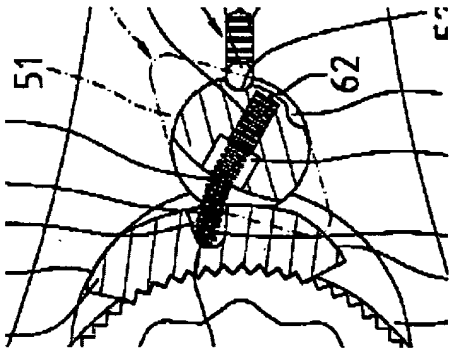


Claims 21-25, 40-59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 4, 27, 34-37 of U.S. Patent No. 6,282,992.

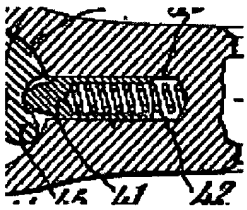


Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matter claimed, i.e., a peg having a receptacle and a head as shown in Figs. 2 and 7 is fully disclosed in the above mentioned US Patent, Figs. 2 and 9.

Claims 21-25, 40-41 and 57-59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No. 6,282,991 in view of Kress.



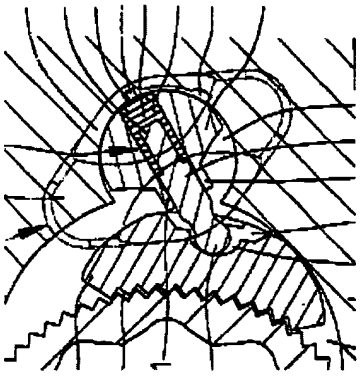
The above-mentioned US Patent claims all the limitations except for a peg with a receptacle. Kress discloses a switch member actuating the pawl with a spring-loaded plunger, spring loaded peg as illustrated by Kress is old and known in the art. It is known in the art, to use spring loaded peg or a pin to shift the pawl. The two are art recognized functional equivalents. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tool of above mentioned Patent by replacing the actuating member with a peg including a receptacle, in view of Kress, as the two are art recognized functional equivalents.

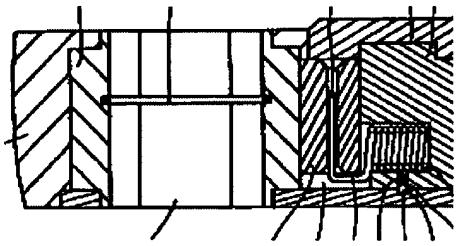


Claims 21-25, 40-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 09/814,430 (now US 6,453,779) in view of McCann.

Because subject matter claimed, i.e., a peg having a second receptacle and a head is claimed in the above mentioned US application, Figs. 2, 7 and 9. Regarding the head, the

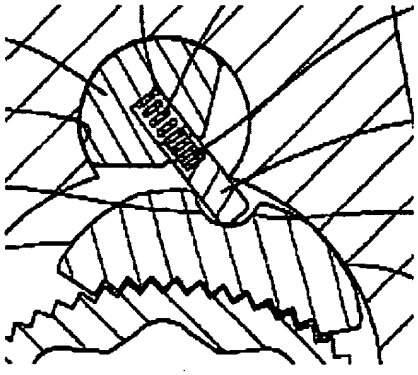
Application discloses all the limitations except for an end wall defining the opening having a smaller diameter being received in an annular shoulder of the drive member. As indicated in the cited reference McCann, Figs. 1 and 2, these limitations and embodiment are old and known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tool of above mentioned Application by replacing the head, with one as disclosed in McCann as the two are art recognized functional equivalents.





This is a provisional obviousness-type double patenting rejection.

Claims 21-25, 40-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 09/923,120 (now US 6,457,389) in view of McCann and Chen.



Because subject matter claimed, excluding the head as shown in Figs. 2 and 7 is disclosed in the above-mentioned US application, Figs. 1, 2, 9 and 10. Regarding the head, the Application discloses all the limitations except for an end wall defining the opening having a smaller diameter being received in an annular shoulder of the drive member and a drive column with a stub. As indicated in the cited references McCann, Figs. 1 and 2, and Chen, Figs. 1 and 2, these limitations and embodiment are old and known in the art, and would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tool of above mentioned Application in view of McCann and Chen as functional equivalents known in the art.

This is a provisional obviousness-type double patenting rejection.

Claims 21-25, 40-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-60 of copending Application No. 09/854,795 in view of Fosella, Kress, McCann and Chen.

Because subject matter claimed, i.e., the pawl, switch member, and elastic member are claimed in the above-mentioned US application, Figs. 1, 2, 9 and 10, except for a peg having a second receptacle with a second end wall, a head with an opening and the drive column. Regarding the head, the Application discloses all the limitations except for an end wall defining the opening having a smaller diameter being received in an annular shoulder of the drive member and a drive column with a stub. As indicated in the cited references McCann, Figs. 1 and 2, and Chen, Figs. 1 and 2, these limitations and embodiment are old. Regarding the peg with the receptacle Fosella, Figs. 3 and 5 discloses a switch member actuating the pawl with a spring-loaded plunger 130, thus spring loaded peg as further illustrated by Kress, Figs. 1 and 2., is old and an and would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tool of above mentioned Application in view of prior art as functional equivalents known in the art.

This is a provisional obviousness-type double patenting rejection.

Claims 21-25, 40-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 09/888,810 in view of McCann and Chen.

Because subject matter claimed, i.e., as shown in Figs. 2 and 7 is disclosed in the above-mentioned US application, Fig. 6. See above

This is a provisional obviousness-type double patenting rejection.

(11) Response to Argument

It is not the position of the Examiner that since all the elements are old therefore, the combination as claimed is old, rather to illustrate a point that different means of biasing is well known in the art. In response to Appellant 's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, the equivalency for different means of biasing a pin, i.e., same means, same function and same way of operation is met by the biasing means in the main reference (Kilness) and the teaching reference (Tuttle). The Appellant argument that the biasing means are used for different purpose, i.e., Kilness biases the pawl whereas Tuttle biasing means is the pawl is not persuasive specially in view of Fig. 4 in the main reference Kilness. Kilness in Fig. 4 discloses another embodiment for biasing the pawl wherein the actuating member includes a hole in which one end of biasing means, e.g., spring (46) and pin (47) is inserted, illustrating other embodiment for biasing the pawl in addition to biasing a pin (25) by spring 29 received on the outside of the pin. Tuttle teaches a means for elastically biasing a pin wherein the spring is received within the pin. And since as indicated in the Office Actions, Appellant does not indicate any reasons for the spring to be received within the pin, the specific embodiment claimed, and since in the other embodiments, e.g., Fig. 1, wherein the pin is received within the spring, Appellant seems to indicate, much like the main reference, Kilness, other means by which the

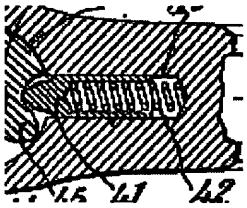
pawl may be biased against the ratchet wheel, the obviousness modification was applied, since Tuttle discloses the embodiment claimed for biasing a pin.

The argument regarding movement of the pin and the spring relative to the drive member is not persuasive for the same reasons stated above. Kilness discloses different means of biasing the pawl utilizing a pin and a spring received on the outside of the pin, however, Tuttle discloses biasing means comprised of a pin and a spring received inside the pin, as another embodiment. The argument that the wench of Tuttle is not reversing is irrelevant since as indicated by the Examiner, different biasing means are the difference between the claimed invention and the main reference and the teaching from Tuttle is a pin being biased by a spring within a receptacle in the pin. Finally, Appellant argues that if these means are functionally equivalent, that in itself does not render the claims obvious. In response it is noted that Appellant has not disclosed that utilizing a spring received within a pin solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the actuating means as disclosed by other embodiments and it is further noted as an illustration, that even Tuttle does not claim for the pin or pawl (24) to have a recess in which the spring is received and only claims a spring biasing the pawl making the point as argued by the Examiner of it being a routing modification for one of ordinary skill in the art.

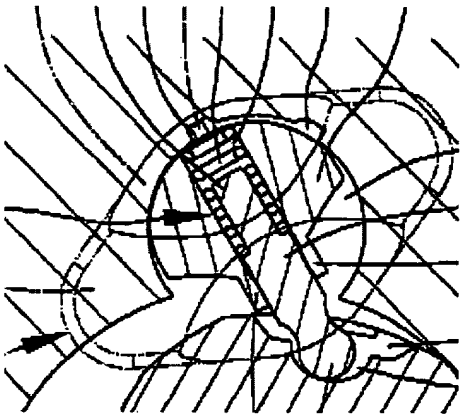
In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would be motivated to make the modification,

e .g., in order to reduce or substantially prevent the pin to rotate in its longitudinal axis due to frictional force between the spring the pin's receptacle for enhanced and smoother operation.

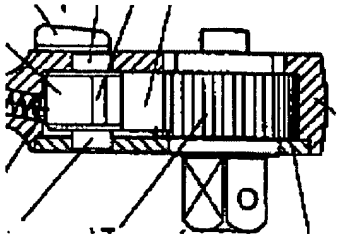
With regards to the double patenting rejections, Applicant agrees to file a terminal disclaimer relating to US Patent No. 6,282,992 (See Brief, page 11).



Relating US 6,282,991 over Kress in which a pin is biased by a spring located within a recess in the pin, Appellant again makes the argument that there should be a clear teaching or suggestion to combine, to which same response as indicated above is noted, including prevention of pin's axial rotation.



Regarding US Patent No. 6,453,779, double patenting rejection over McCann; Appellant argues the advantages of the patent over the Kilness and that McCann teaches a spring received in a hole of the actuating member. McCann was applied to indicate a head structure having and end wall as disclosed in McCann Figs. 1 and 2 and not to teach biasing means.



Regarding US Patent No. 6,457,389, and US Pub. 2002/0166416 (US Application 09/888,810) double patenting rejection over McCann and Chen; Appellant argues that there is no extension of patent exclusivity in the present Application. US Patent 6,457,389 e.g., claim 5, and US Pub. 2002/0166416, claim 13, recite a pin with a receptacle wherein a spring is received, McCann and Chen are cited to modify the tool for adaptation with a drive column instead of a polygonal drive cavity and head structure having an end wall.

Regarding US Pub. 2002/0112573 (US Application 09/854,795), the claims recite all the structures except for a pin having a receptacle receiving the spring and the head structure or the drive column. However, for the sake of simplicity at least claim 10 of the US Application

09/854,795 recites all the limitations of claim 1 of the instant Application except for biasing means to include a pin having a receptacle wherein the spring is received. Kress teaches a biasing means comprised of a pin having a receptacle wherein the spring is received. For the same reasons as indicated above, e.g., enhance operation of the pin (minimal axial rotation), motivation or suggestion within the knowledge of one of ordinary skill in the art, would render at least claim 1 of the instant Application an obvious modification over Kress.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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HS
May 22, 2003

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